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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,525	11/19/2003	Toshiki Maeda	08009.0008	4709
22852	7590	01/25/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1795	
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			01/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/715,525  
Filing Date: November 19, 2003  
Appellant(s): MAEDA ET AL.

\_\_\_\_\_  
Finnegan, Henderson, Farabow, Garrett and Dunner, L.L.P.  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 3/15/2007 appealing from the Office action mailed 7/12/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The statement of the status of claims contained in the brief is correct.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

EP0944125

Sunagawa et al.

9-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Sunagawa et al. (EP 0944125).

Sunagawa et al. discloses a lithium secondary battery using the active material for a positive electrode (page 2 lines 53-54) which is expressed by the general formula  $\text{LiX}(\text{Ni}_{1-y}\text{Co}_y)_{1-x}\text{MzO}_2$  (where  $0.98 \leq x \leq 1.10$ ,  $0.05 \leq y \leq 0.4$ ,  $0.01 \leq z \leq 0.2$ , M at least one element selected from the group of Al, Zn, Ti and Mg) (page 2 lines 55-57), and the average particle size of the spherical secondary particles is 3.0 to 20.0um (page 2 line 54) which is in the range of appellant's claimed size of 5-15um. Sunagawa et al. discloses specific surface area of between 0.15 to 2.0m<sup>2</sup>/g (page 3 lines 20-21).

Since Sunagawa et al. discloses the same active material desired by the appellant, it is inherent that according to the Rietveld analysis, the Li site occupancy rate for the Li site in the crystal is 98% or greater.

As to the active material being subjected to a washing process, the washing process is an intended use. It has been held that a recitation with respect to the manner in which the claimed particle is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987)

#### **(10) Response to Argument**

In response to appellant's argument that Sunagawa fail to teach wherein the lithium site occupancy rate is 98% or greater, Sunagawa discloses the same active material desired by the appellant which is expressed by the general formula  $\text{LiX}(\text{Ni}_{1-y}\text{Co}_y)_{1-x}\text{MzO}_2$  (where  $0.98 \leq x \leq 1.10$ ,  $0.05 \leq y \leq 0.4$ ,  $0.01 \leq z \leq 0.2$ , M at least one element selected from the group of Al, Zn, Ti and Mg) (page 2 lines 55-57) , therefore it is inherent that according to the Rietveld analysis, the Li site occupancy rate for the Li site in the crystal is 98% or greater. Appellant argues that the comparative examples and the examples shown in the specification have the same composition but not necessarily have the same Li site occupancy rate. However, once a reference teaching product appearing to be substantially identical is made in the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the appellant to show an unobvious difference. MPEP 2112 section V. Appellant has not shown an unobvious difference between the prior art and appellant's invention. Appellant described the difference between the comparative examples and the examples shown in the specification but did not describe the difference between appellant's invention and the prior art.

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Appellant further argues that Sunagawa fail to disclose controlling the manufacturing process of its lithium composite oxide therefore would not have the same Li site occupancy rate. Appellant did not claim that the active material is created by controlling the manufacturing process of its lithium composite oxide. Also, data needs to be available that controlling the manufacturing process of its lithium composite oxide of appellant's invention differ from the lithium composite oxide of the prior art. Appellant states in the specification that comparative examples 4 and 5 that the nickel concentration was controlled thereby providing particles in the range of 4.8-16um (page 12). Sunagawa discloses the same material desired by the appellant within the particle range desired by the appellant and since, appellant teaches that controlling the nickel concentration provides the particles to be in the range of 4.8-16um thus the Li site occupancy rate for Li sites would inherently be 98% or greater as shown in appellant's specification in table 1, comparative examples 4 and 5, then Sunagawa inherently discloses the same Li site occupancy rate for Li sites.

As to the active material subjected to a washing process, the difference between the specific surface area of the active material before the washing process and after the washing process is  $1.07\text{m}^2/\text{g}$  or less, Appellant argues that before and after the recited washing process is a property of the active material. Sunagawa discloses the same active material desired by the appellant which is expressed by the general formula  $\text{LiX}(\text{Ni}_{1-y}\text{Co}_y)_{1-x}\text{MzO}_2$  (where  $0.98 \leq x \leq 1.10$ ,  $0.05 \leq y \leq 0.4$ ,  $0.01 \leq z \leq 0.2$ , M at least one element selected from the group of Al, Zn, Ti and Mg) (page 2 lines 55-57) and that the specific surface area is between  $0.15$  to  $2.0\text{m}^2/\text{g}$  (page 3 lines 20-21) and since the

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difference between the specific surface area of the active material before the washing process and after the washing process is  $1.07\text{m}^2/\text{g}$  or less, the difference could be zero  $\text{m}^2/\text{g}$  therefore, Sunagawa does not need to disclose a difference between the specific surface area of the active material before the washing process and after the washing process.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jane Rhee

Conferees:

Pat Ryan



Bill Krynski



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10715525	11/19/03	MAEDA ET AL.	08009.0008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

**EXAMINER**

Jane Rhee

**ART UNIT****PAPER**

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20080121

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**Commissioner for Patents**

Corrected examiner's answer is enclosed.

Jane Rhee  
January 21, 2008